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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,976	05/14/2001	Scott LeKuch	YOR920000704US3	9088

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EXAMINER

SHENG, TOM V

ART UNIT

PAPER NUMBER

2673

10

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,976

Applicant(s)

LEKUCH ET AL.

Examiner

Tom V Sheng

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-14, 16-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-14, 16-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 16 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is dependent on claim 15. However, claim 15 is cancelled making claim 16 indefinite.

As for claims 16 and 22, it is unclear how exactly a user can specify a location region for the pre-printed unique identifier, when the location is already pre-determined due to the pre-printed aspect.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-14, 16-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruedisueli et al. (US 5838819) and Flickinger et al. (US 5629499).

As to claim 1, Ruedisueli teaches a digitizer input system (figures 1-4; electronic notepad 10) for inputting written information from a user, said input device system comprising:

at least one sheet of a writing medium (sheet of paper 30);

an electronic pen for writing on said writing medium and emitting one or more signals for generating pen stroke information (figure 9; Ruedisueli teaches that pen device 114 can be electronically connected to notepad 10 by a signal-carrying cable for providing data signals to processor 12 through writing on the notepad surface 26; column 8, lines 50-64); and

local storage (memory 16) for storing said detected pen stroke information, in association with an unique identifier of said writing medium (figures 4 and 5; column 4, lines 31-38; column 5, lines 16-32; column 6, lines 12-23).

Ruedisueli's unique identifier 36 is written into the paper at the upper right corner and to be recognized by the handwriting-capturing device 24 having operative surface 26. See figure 1, column 3, lines 23-28, 40-46; column 4, lines 5-17, 39-56; column 8, line 65 - column 9, line 2.

Ruedisueli does not teach the writing medium having a pre-printed unique identifier, a detector for detecting said pre-printed unique identifier and said pen stroke information from said emitted signal; and a local storage for storing said detected pen stroke information, in association with said pre-printed unique identifier of said writing medium.

Art Unit: 2673

Flickinger teaches an electronic board that stores and transfers handwritten information. Further, the board can recognize forms or papers by various identifier mechanisms (figure 5, column 3, line 43 - column 4, line 2). In particular, the form 200 can have a bar-code 204, which is read by a bar-code reader 118 located under a clip. The recognition is automatic as soon as the form is secured by the clip. Note Flickinger specifically claimed the equivalency between forms and papers in the claims.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate Flickinger's papers with pre-printed bar-codes and a bar-code reader into Ruedisueli's electronic notepad, thus providing an automatic and error free recognition of a form/paper with a user's involvement.

As to claim 2, Ruedisueli teaches wherein said input system is coupled to a computing device (figure 1; processor 12; column 3, lines 1-4).

As to claim 3, Flickinger's bar-code is an image.

As to claim 4, Flickinger's bar-code is scanned by the bar-code reader.

As to claims 7 and 9, Ruedisueli teaches a display for displaying said unique identifier (output device 20 of notepad 10 can be a display; figure 1; column 3, lines 29-33).

As to claim 8, Ruedisueli does not teach associating a time stamp with detected pen stroke information. On the other hand, Ruedisueli teaches that the identifier can also be generated by a timestamp using a timer (column 4, lines 65-67). The generation of a timestamp type of unique identifier and the association of a timestamp

Art Unit: 2673

to pen strokes (in probably a page or session) are just different ways of applying a time signature to a piece of information.

As to claim 10, Ruedisueli as modified by Flickinger would associate stored pen stroke information, if any, with each pre-printed unique identifier.

Claim 11 is a method claim corresponding to apparatus claim 1 and is rejected accordingly.

Claims 12 and 13 are rejected per analyses of claims 7, 9 and 11.

Claim 14 is rejected per analyses of claims 4 and 11.

As for claim 16, the user certainly specifies the location where the pre-printed unique identifier is located.

Claim 17 is rejected per analyses of claims 8 and 11.

Claim 18 is a storage medium claim corresponding to apparatus claim 1 and is rejected accordingly. Further, Ruedisueli's stored programs 18 (figure 1) reads on claimed computer readable program instructions.

Claims 19 and 20 are rejected per analyses of claims 7, 9 and 18.

As for claim 22, the user certainly specifies the location where the pre-printed unique identifier is located.

Claim 23 is rejected per analyses of claims 8 and 18.

Claim 24 is rejected per analyses of claims 4 and 18.

Art Unit: 2673

Response to Arguments

5. Applicant's arguments with respect to claims 1-4, 7-14, 16-20 and 22-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Sheng
March 6, 2004


Amare Mengistu
Primary Examiner